REMARKS

Claims 1, 6, 7, 10, 24, 27, 28, 36-41, 43, 50, 53, 55, 57, 59, 64, 67, 69, and 72-90 are in the case. Claims 2-5, 8, 9, 11-23, 25, 26, 29-35, 42, 44-49, 51, 54, 56, 58, 60-63, 65, 66, 48, 70, and 71 have been cancelled without prejudice or disclaimer by the above amendment. It is to be noted that there was no Claim 52 in the case as filed although the filing fee as paid in the case included payment for such a claim.

Support for the amendments made in the claims and for the new claims can be found for example at Page 3, lines 6-7; Page 7, line 12 to Page 11 line 17; the Examples of the invention appearing on Pages 48 to 63; and the original claims as presented in this application.

The above amendment is made with a view toward avoiding the payment of unnecessary fees for extra claims. As the accompanying fee calculation sheet indicates, the only payment required at this time is the payment for the use of multiple dependent claims.

Reconsideration is requested in light of the following comments in which the comments are keyed to the numbering given in the Action.

1-8. Restriction has been required to one of the following inventions, which are described in the Action substantially as follows:

I. Claims 1-5, 14, 16-19, 28, 30, and 70, drawn to a compound, classified in class 252, subclass 400.24;

II. Claims 6-13, 15, 20-27, 29, 31-35, 42-63, and 71-75 drawn to a method of making the granular polymer additive compound in granular form, classified in class 252, subclass 400.23;

III. Claims 36-41, drawn to a process of making granules, classified in class 252, subclass 404;

IV. Claims 64-69, drawn to an additive system, classified in class 252, subclass 407.

Applicant respectfully traverses this requirement and requests reconsideration and withdrawal of the requirement.

First of all, it is to be noted that the basis for the restriction between inventions II and III is in error. Contrary to the statement in the Action, the granular product as claimed cannot be made by first melting the sterically-hindered compound and then adding it to a friability

reduction agent followed by forming granules and drying. The process claims specifically set forth that the conditions used are ineffective to melt the phenolic compound. Indeed, new generic Claim 76 specifies that the conditions are ineffective to melt any solid component of the agglomerates or pellets being produced.

Secondly, as pointed out in MPEP 803, second paragraph:

> If the search and examination of an entire application can be made without **serious burden**, the examiner **must** examine it on the merits, even though it includes claims to independent or distinct inventions.
> [Emphasis added]

The Action makes no suggestion that the Examination of all of the claims would constitute a **serious** burden. Moreover, the areas of search have already been identified and examination of all claims has already been paid for by the extra fees paid for the claims when filing them.

Furthermore, 35 U.S.C. §121 gives the Commissioner discretion to require restriction -- it is not mandatory. Also, it is not seen that the Office would be put to any undue extra work by examining all of the claims in this case rather than conducting the prosecution piecemeal. In addition, in the long run the public, the Office and the applicant would be benefitted by conducting the prosecution *in toto* in one application rather than carving the subject matter up into separate applications which would require separate files, separate examinations, separate prosecutions, and separate patents, to say nothing of the extra expenses to all concern. Accordingly, Applicant traverses the foregoing requirement. The wisdom of, and indeed the urgent need for, the reducing the generation of multiple documents and multiple files can be seen from *General Electric Company v. Brenner*, 159 U.S.P.Q. 335 (C.A.D.C. 1968):

> Filing cabinets abhor redundancy. Warehouses covet their space. The overcrowded conditions of offices in this city are in direct ratio to the space needed for storing of documents. The Patent Office was conceived by a document and has been prolific in that regard from its inception. These considerations warrant an economizing of words so as to alleviate these serious conditions. We do not feel that this economy will be at the expense of clarity and thereby frustrate the effectiveness of the statute. We expound a rule of reason and apply it to the statute in the light of the surrounding circumstances.

This alarm signal, although prompted by the question of incorporation by reference, applies with at least as much force to the question of requirements for restriction which cause the generation of enormous amounts of unnecessary paperwork, expense, and in the long run, disservice to the public.

To be fully responsive, Applicant affirms the provisional election to prosecute the invention of Group III involving Claims 36-41 and new claims 76-90, which election was made, and again is made, with traverse. It is to be noted that Claims 72-75 relate to dried granules made according to the process of various elected process claims. Thus, it is submitted that at least these claims should be examined in the same application.

9-11. These sections require no comment.

12. The rejection of Claims 36-41 under 35 U.S.C. 102(b) as anticipated by Gahan EP 0 403 431 or U.S. 5,006,284 (collectively "Gahan" as they presumably have the same substantive disclosure) is deemed inapplicable and untenable as regards not only Claims 36-41 but with regard to new Claims 76-90 as well. The Action fails to establish a *prima facie* case of anticipation, and thus the rejection is deemed unsupportable.

The applied Gahan references disclose formation of granules by introducing a melt of the phenolic ester into a cold aqueous solution of an organic water-miscible solvent (Column 2, lines 3-9 of the U.S. patent; Abstract of the published European patent application). Applicant's amended claims 36-41 and new Claims 76-90 bring out very clearly that the claimed process does not involve melting a phenolic compound and chilling such a melt in a liquid medium. As can be seen from Applicant's Examples of the invention and the disclosure for example at Page 4, lines 2-4 no melt is formed nor is any melt chilled in a cold liquid medium of any kind. Thus, a *prima facie* case of anticipation does not and can not exist based on the applied Gahan references. Thus, the rejection based on Gahan is deemed inapplicable. Reconsideration and withdrawal of this rejection are therefore requested.

13. The rejection of Claims 36-41 under 35 USC 102(b) on Marutani et al. U.S. 5,117,040 also fails to establish a *prima facie* case of obviousness. The fact is that Marutani describes a crystallization process which has nothing whatsoever to do with a process for forming granules from wet particles by converting them into wet granules and drying the wet granules by removing processing agent from the granules. In the Marutani procedure as

described at Column 4 lines 12-31, a specified phenolic compound "is completely melted by heating to 120° to 130°C" and "[A]after complete melting, dropwise addition of the crystallization solvent employed is started and the whole amount thereof is added under reflux." After the addition by dropping is completed a clear and transparent system is obtained. The reference continues:

> "Then the oil bath is removed and, after termination of refluxing, a small amount of alpha crystals are charged as seed crystals. When allowed to cool, the contents begin to become turbid, indicating the start of precipitation of crystals. From this time point, the contents are maintained at a temperature of 60° to 50°C for about 1.5 to 3 hours for the growth and maturation of crystals. Thereafter, the oil bath is removed and the contents are allowed to cool gradually until crystal precipitation is complete. The desired product is then recovered by solid-liquid separation."

From this description one of ordinary skill in the art would realize immediately that such a crystallization process has nothing to do with processes in which small particles are caused to become larger granules or aggregates (*e.g.*, agglomerates or pellets) without dissolving the particles and without crystallizing the dissolved solute by seeding and cooling. Thus, one of ordinary skill in the art would recognize that Marutani deals with and describes processing which is entirely different from the processing called for by the present claims.

The reliance on Comparative Example 1 in the Action is to no avail. The mixture formed in Marutani Comparative Example 1 is melted and then crystallized in a liquid medium, recovered therefrom, and dried. Crystals, not granules, are formed and the mixture is melted before crystallization. More particularly, in Comparative Example 1, a "homogeneous solution was prepared by heating to 68°C and crystallization was effected as described in Example 2." In Example 2, a product formed by the procedure described in the first paragraph of that Example is subjected to the procedure of Example 1 to convert that product into crystals. The procedure of Example 1 involves "complete melting of the product" (Column 5, lines 1-2). To this melt was added the crystallization solvent (methanol-water) under reflux. A clear solution is formed, the oil bath is removed, and the contents of the flask are allowed to cool. Then seed crystals are added and the crystallization procedure as described in Column 4 of Marutani (and discussed above) is completed.

Such a process has no resemblance whatever to the subject matter as claimed in the present application. For example, in Applicant's claimed process no product is completely melted. Instead wet granules are formed from a paste and then converted into dried granules by removing the liquid processing agent from the paste. In this connection, we respectfully note that the statement in the Action that Comparative Example 1 of Marutani forms a paste that is then melted to form a solution followed by crystallization and drying to form a crystal granular product, even if a correct interpretation of Marutani, does not describe subject matter bearing any resemblance to the presently-claimed subject matter.

For the reasons given above a *prima facie* case of anticipation by Marutani does not exist and we submit, can not exist. The respective technologies are distinct and unrelated to each other and one of ordinary skill in the art would recognize this distinctness and lack of relationship. Thus, this rejection is deemed untenable and should be reconsidered and withdrawn.

14. The rejection based on Yi U.S. 4,357,449 under 35 USC 102(b) is also erroneous as it fails to establish a *prima case* of anticipation. In the first place, the reference is clearly in a non-analogous art as it deals with dispersion polymerization of cycloolefins by ring-opening polymerization. Anyone seeking information concerning how to form a granular additive comprised of a phenolic antioxidant would have no reason whatsoever to consult a reference dealing with formation of polymers by a slurry polymerization process.

But even assuming, for the sake of argument, that one of ordinary skill of the art happened to stumble over Yi despite its irrelevant subject matter, one skilled in the art would find no basis therein for information on how to form granules of an antioxidant. What Yi discloses in Column 8 is the formation of a mixture of a polymer dispersion in a 90% ethanol mixture, followed by filtration. The filtered polymer is then reslurried in 2500 mL of a 90% ethanol mixture which contains 3 parts of a hindered phenol antioxidant per 100 parts of weight of polymer. On evaporation of the ethanol, a polymer is obtained which contains a phenolic antioxidant. Such a process is vastly different from the subject matter of the present claims which specify formation of a paste which is processed into the form of wet granules (*i.e.*, agglomerates or pellets) which are then dried. Accordingly, this rejection should be reconsidered and withdrawn.

In may be worth noting in connection with Sections 12, 13, and 14 above, that as to the requirements for establishing a *prima facie* case of anticipation, *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193, (Fed. Cir. 1983) points out:

> Anticipation requires the presence in a single reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Further, "[u]nder 35 U.S.C. §102, anticipation requires that . . . the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public." *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986) (citing *In re Brown*, 329 F.2d 1006, 1011, 141 USPQ 245, 249 (C.C.P.A. 1964). The Federal Circuit has added that the anticipation determination is viewed from one of ordinary skill in the art: "There must be no difference between the claimed invention and the reference disclosure as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genetech Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

15. This section requires no comment.

16-19. The rejections based on the judicially created doctrine of obviousness-type double patenting appearing in sections 16-18 and the provisional rejection based on the judicially created doctrine of obviousness-type double patenting of Section 19 are rendered inapplicable by the accompanying terminal disclaimers and papers authorizing the payment of the associated fees therefor.

20. As indicated on the first page of the present application, the present application has been designated as a continuation-in-part of three commonly-owned applications which were pending in the PTO when the present application was filed. These three applications are:

1) Application no. 09/158,588 (now U.S. 6,056,898) which was pending when the present application was filed;
2) Application no. 09/204,121, (now U.S. 6,126,863) which was pending when the present application was filed; and
3) Application no. 09/203,941, (now U.S. 6,126,862) which was pending when the present application was filed.

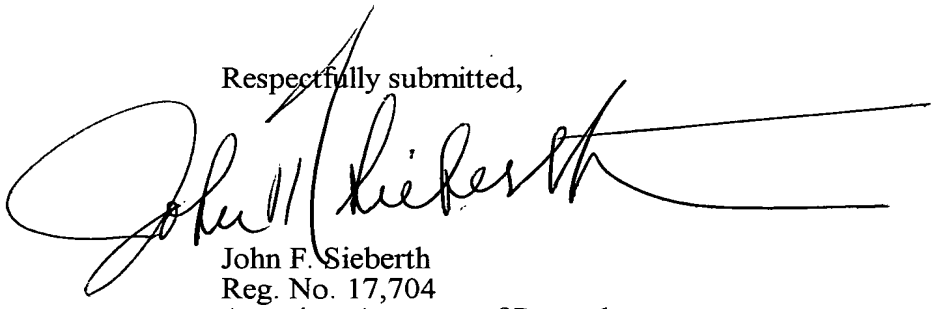
In other words, the attorney that prepared the present application 09/528,675 identified it (*i.e.*, 09/528,675) as a continuation-in-part of three prior copending applications, namely those that subsequently issued as U.S. 6,056,898, U.S. 6,126,862, and U.S. 6,126,863.

For reasons given above, it is believed that the case is in condition for allowance. Favorable action on the claims is therefore solicited.

If any matters remain that require further consideration, the Examiner is requested to telephone the undersigned at the number given below so that such matters may be discussed and, if possible, promptly resolved.

Please continue to address all correspondence in this Application to Mr. Edgar E. Spielman, Jr. at the address of record.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that in accordance with standard business practice, this paper (along with any referred to as being attached or enclosed) is to be deposited on the date shown below with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

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